



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,100	11/14/2001	Jun Kishimoto	81839.0106	3823

26021 7590 04/07/2004

HOGAN & HARTSON L.L.P.
500 S. GRAND AVENUE
SUITE 1900
LOS ANGELES, CA 90071-2611

EXAMINER

DEO, DUY VU NGUYEN

ART UNIT PAPER NUMBER

1765

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/002,100

Applicant(s)

KISHIMOTO, JUN

Examiner

DuyVu n Deo

Art Unit

1765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Art Unit: 1765

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Edmonds et al. (US 4,144,099).

Edmonds teaches a semiconductor wafer having a back face having grinding striations (since the back face is grinded) and a front face having no grinding striations (since it is not grinded) (ab.).

Referring to the method limitations of making the semiconductors in claims 1 and 6, since the patentability of a product is independent of how it was made. *Ex parte Jungfer* 18 USPQ 2d 1796, 1800 (BPAI 1991); *Brystol-Myers Co. v. U.S. International Trade Commission* 15 USPQ 2d 1258 (Fed. Cir. 1989); *Ex parte Allen* 2 USPQ 2d 1425,1427 (BPAI 1987); *In re Thorpe* 227 USPQ 964 (Fed. Cir. 1985); *In re Dike* 157 USPQ 581 (CCPA 1968); *In re Stephens* 145 USPQ 656 (CCPA 1965); *In re Hoeksema* 141 USPQ 733,736 (CCPA 1964); *In re Smith* 74 USPQ 207 (CCPA 1947), it is a burden to the applicant to show evidence that there is different in the product of the admitted prior art and claimed product. Please see *Ex parte Jungfer* 18 USPQ 2d 1796, 1800 (BPAI 1991); *Brystol-Myers Co. v. U.S. International Trade Commission* 15 USPQ 2d 1258 (Fed. Cir. 1989); *Ex parte Allen* 2 USPQ 2d 1425,1427 (BPAI 1987); *In re Thorpe* 227 USPQ 964 (Fed. Cir. 1985); *In re Dike* 157 USPQ 581 (CCPA 1968); *In re Stephens*

Art Unit: 1765

145 USPQ 656 (CCPA 1965); *In re Hoeksema* 141 USPQ 733,736 (CCPA 1964); *In re Smith* 74 USPQ 207 (CCPA 1947). Burden is on applicants to show differences in product comparisons. *Ex parte Gray* 10 USPQ 2d 1922, 1925 (BPAI 1989).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edmonds as applied to claim 6, and further in review of admitted prior art.

Unlike claimed invention, Edmonds doesn't describe the micro roughness on the back surface has P-V value of 30-50nm and intervals of 1-10 mm. Admitted prior art describes a semiconductor wafer having micro roughness on the back surface has P-V value of 30-50nm and intervals of 1-10 mm (page 2 of specification) that come from the conventional grinding and polishing process. It would have been obvious to one skill in the art at the time of invention to determine the micro roughness in light of admitted prior art because admitted prior art describes further processing parameters that is silent by Edmonds. Also as described in page 3, lines 1-6 of the specification that it is important or desired to be able to distinguish between the front and back surface of the wafer. Therefore, it would be obvious that the micro roughness on the back surface would have to be determined through test runs for the distinguishing between the front and back surface.

Art Unit: 1765

Response to Arguments

5. Applicant's arguments with respect to claims 1, 6, 7 have been considered but are moot in view of the new ground(s) of rejection.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DuyVu n Deo whose telephone number is 571-272-1462. The examiner can normally be reached on 6:00-3:30; with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton can be reached on 571-272-1465. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DVD
3/31/04

Go